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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,117	07/11/2003	Caroline Sassano Stone	06147D USA	4103

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EXAMINER

METZMAIER, DANIEL S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/618,117	Applicant(s) SLONE ET AL.	
	Examiner Daniel S. Metzmaier	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 Dec 2005 & 9 Jan 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13,14,18 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13,14,18 and 24-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 13-14, 18 and 24-29 are pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 25, it is unclear how the water-borne, water-dispersible or water-soluble resin or mixtures thereof could possibly be 99 wt % since the minimum of the remaining components is greater than 1 wt %, i.e., 1.03 wt %.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 27 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schäfer-Burkhard, US 4,311,618. Example 5 of the reference discloses the claimed incorporation of the claimed compounds in an aqueous cleansing composition. The foam control function would have been inherent to the compound disclosed in the Schäfer-Burkhard reference. A compound and all of its properties are generally inseparable. See *In re Papsech*, 315 F2d. 381, 137 USPQ 43, (CCPA 1963).

To the extent the Schäfer-Burkhard reference employs the HCl salt rather than the non-salt form of the compound per se, the salt form is a conventional form of adding the compounds of the claims for water solubility and dispersibility, which is the intended system being utilized instantly and in the prior art.

Furthermore, claim 27 sets forth the alkyl glycidyl ether-capped polyamines, which one skilled in the art would have expected to have basic amino groups and 0.01 to 20 wt% of a water-soluble inorganic acid, i.e., HCl. Said acid and the alkyl glycidyl

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ether-capped polyamine would have been expected to form the salt in acidic aqueous media, which the claim reads. The claimed subject matter reads on the Schäfer-Burkhard salts.

To the extent the Schäfer-Burkhard reference differs regarding the use of the compounds as foam control agents or the use of the salt, the foam control properties in water-borne systems would have been expected to be the same or to vary slightly with the hydrophobicity of the agents employed. Applicants have provided no evidence that the salt form or the particular compounds employed would have been critical to the inventive compositions.

7. Claims 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lassila et al, US 5,939,476, in view of Takemoto Yushi KK, JP S52-10847 (Translation provided by applicants, see IDS file July 11, 2003).

Lassila et al '476 disclose (column 5-6 and claims 16-18) typical compositions including organic coating, ink, and agricultural compositions employing 0.01, 0.01 or 0.1 wt%, respectively, of an alkylated polyamine wetting agent. Lassila et al '476 (column 2, lines 58 et seq) recognizes the prior art use of related alkylated polyamines having antimicrobial properties.

Lassila et al '476 differs from the instant claims in the incorporation of the alkyl glycidyl ether-capped polyamine.

Takemoto Yushi KK, JP S52-10847, (Translation) disclose methods of making alkyl glycidyl ether-capped polyamine compounds having antimicrobial or bactericidal

properties for addition to aqueous systems, such as bouillon culture medium (page 10, translation) to mitigate bacterial or mold growth.

These references are combinable because they teach related polyamine compounds recognized in the art for their bactericidal properties. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to employ the bactericides of Takemoto Yushi KK, JP S52-10847, in the compositions of Lassila et al '476 as an antimicrobial for the advantage of mitigating microbial growth in aqueous compositions specifically provided for in the organic coating compositions.

One having ordinary skill in the art at the time of applicants' invention would have reasonably expected the addition of the agents taught in the Takemoto Yushi KK, JP S52-10847, reference to mitigate growth of bacteria and/or mold in the aqueous compositions of Lassila et al '476, which as aqueous compositions containing organic resins, thickeners, stabilizers, and/or surfactants would have been prone to mold and/or bacterial degradation upon lengthy storage. The defoaming properties recited in the instant claims would have been expected to have been inherent to the bactericidal compounds disclosed in the Takemoto Yushi KK, JP S52-10847, reference. A compound and all of its properties are generally inseparable. *In re Papsech*, 315 F2d. 381, 137 USPQ 43, (CCPA 1963).

The overprint varnish and adhesive is an organic coating composition as disclosed in the Lassila et al '476 reference. The fountain solution is an ink composition for planographic printing (see Table at instant page 11).

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 13-14, 18 and 24-29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-19, 23, and 25-29 of copending Application No. 10/112,537. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims encompass the copending claims. Specific attention is directed to the use of polyamines having R groups defined as C4-18 or C1-C10 hydroxyalkoxyalkyl groups. See further the copending specification, which defines the polyamines employed including at least page 4, lines 15-18; and page 12, lines 1 et seq..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

10. Applicant's arguments with respect to claims 13-14, 18 and 24-29 have been considered but are moot in view of the new ground(s) of rejection.

11. The allowability of claims 13-14 and 18 has been withdrawn at this time but would be allowable if the provisional obviousness double patenting rejection were overcome.

Conclusion

12. It is noted that the attorney/agent that has filed the responses in this case has not been given power of attorney by the applicants, which does not allow for the examiner to orally resolve outstanding issues. See MPEP 408: "Registered attorneys or agents not of record in a patent application and acting in a representative capacity under 37 CFR 1.34* should not be telephoned for restriction requirements, approval of examiner's amendments, or given any information relative to such patent application by telephone**>."

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM